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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/748,192

12/31/2003

Pei Kan

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BACON & THOMAS, PLLC

625 SLATERS LANE

FOURTH FLOOR

ALEXANDRIA, VA 22314-1176

EXAMINER

HOLLOMAN, NANNETTE

ART UNIT

PAPER NUMBER

1612

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/748,192	<b>Applicant(s)</b> KAN ET AL.	
	<b>Examiner</b> NANNETTE HOLLOMAN	<b>Art Unit</b> 1612	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

This Office Action is in response to the Request for Continued Examination filed on October 22, 2009. Applicants' arguments, filed October 22, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

### ***Claim Rejections - 35 USC § 103 (New Rejection)***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1) Claims 1-21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawhney (US Patent No. 6,632,457) in view of Jeong et al. (US Patent No. 6,841,617).

Sawhney discloses compositions and methods for control release of therapeutic species through hydrogels (Abstract). Sawhney discloses the oil phase entraps the drug (column 8, lines 16); wherein the drug, which may be denatured by contact with water, are suspended within said oil phase to form a dispersion (column 13, lines 22-31); said oils may be castor oil and fatty acid wax (column 8, line 12-13 and column 13, line 39). Sawhney disclose the oil phase not only stabilizes but also controls the release rate (column 13, lines 34-36). Sawhney discloses the dispersion may be emulsified to form an oil-in-water emulsion (column 13, lines 26-28). Sawhney discloses routes of administration of hydro-gel based drug delivery systems include injection, i.e. intra-muscular (column 8, lines 30-34).

Sawhney does not disclose a delivery system wherein the polymer is selected from the group consisting of PEG-PLGA-PEG, PLGA-PEG-PLGA, PEG-PLGA and Poloxamer 407.

Jeong et al. disclose thermogelling biodegradable polymers that eliminate the need for surgical procedures and offers the advantage of the ability to form any desired implant shape (Abstract; column 1, lines 28-30). Jeong et al. disclose the in situ gelling of Poloxamer 407 (column 1, line 46), PEG-PLGA-PEG (column 1, line 54-56), and a polymer of a general structure that would meet the limitation of PEG-PLGA (column 3, lines 20-29). Jeong et al. disclose in Fig 7, wherein the polymers are in aqueous phase at about 27°C and in a gel phase above 30°C; which is considered to meet the limitation of instant claim 11.

Jeong et al. differs from the instant claims insofar as it does not disclose an oil phase.

It would have been obvious to use thermogelling biodegradable polymers as the hydrogel of Sawhney motivated by the desire to form a system that eliminates the need for surgical procedures and offers the advantage of the ability to form any desired implant shape as disclosed by Jeong et al.

2) Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sawhney (US Patent No. 6,632,457) in view of Jeong et al. (US Patent No. 6,841,617) as applied to claims 1-20, 21 and 23-24 above, and further in view of Fowers et al. (US Patent No. 6,592,899, previously disclosed).

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Sawhney in view of Jeong is discussed above and differs from the instant claims insofar as it does not disclose a delivery system wherein the polymer is PLGA-PEG-PLGA.

Fowers et al. disclose PLGA-PEG-PLGA copolymer (EXAMPLE 1) that increases the solubilization capacity and stability of drug solutions thereby enhancing the efficiency and therapeutic effects of the drug (column 3, lines 16-18). Fowers et al. differ from the instant claims insofar as it does not disclose an oil phase.

It would have been obvious to have used the PLGA-PEG-PLGA copolymer in the system of Sawhney in view of Jeong motivated by the desire to increase the stability of drug solutions while diffusing through the aqueous phase thereby enhancing the efficiency and therapeutic effects of the drug as disclosed by Fowers et al.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./  
Examiner, Art Unit 1612

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612